

Docket 83009F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Dale F. McIntyre, et al.

A METHOD AND SYSTEM FOR
MANAGING IMAGES OVER A
COMMUNICATION NETWORK

Serial No. 09/891,751

Filed 26 June 2001

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Group Art Unit: 2152

Examiner: Dohm Chankong

Sir:

SUPPLEMENTAL APPEAL BRIEF PURSUANT
TO 37 C.F.R. 41.37 and 35 U.S.C. 134

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 4, 7, 10-12, 21, 22, 29 and 30 which was contained in the Office Action mailed August 22, 2006.

A timely Notice of Appeal was filed December 18, 2006 which was received in the USPTO on December 20, 2006.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 4, 7, 10-12, 20-22, 29 and 30 are pending in the application and stand rejected.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

All amendments have been entered.

Summary of Claimed Subject Matter

With respect to claim 4, Applicant's invention relates to a method for automatically forwarding a digital media file by a first party (10) to a second party (16) over a communication network (50), said digital media file having at least one digital image file comprising the steps of;

automatically analyzing a digital image media file at a first party (10) for determining if a portion of said at least one digital image file matches an image content identifier 202 (page 13 line 19 to page 14 line 4, & page 24 line 27 to page 25 line 2), said image content identifier (202) having an associated

electronic address of a second party (16) (page 14 lines 10-12, page 35 lines 31-32); and

automatically forwarding said digital image from said first party (10) to said electronic address of said second party (16) over said communication network (50) if said image content identifier (202) matches a portion of said image.

With respect to claim 7, Applicant's invention relates to a method for identifying images by a computer (10) for communication of said images over a communication network (50) to a designated remote location (16), comprising the steps of:

automatically analyzing a digital image;

identifying a feature within said digital image by said computer using pre-established image content identifier (202) having an associated electronic address (page 14, lines 11-12, and page 35, lines 31-32) at a first location (20); and

automatically transmitting said image to a second remote location (16) using the associated electronic address over a communication network (50) for displaying or storing said image based on identifying said feature within said image.

With respect to claim 10, Applicant's invention relates to a system for automatically sharing of images over a communication network (50), comprising:

obtaining at least one image identifier comprising an image content identifier (202) and an associated electronic address (page 14, lines 10-12, and page 35, lines 31-32);

automatically analyzing digital images at a first location (10) different from said associated electronic address for determining if the said image content identifier (202) substantially matches a portion of said images; and

automatically forwarding said images that substantially match said image content identifier over said communication network (50) to said associated electronic address (page 14, lines 10-12, and page 35, lines 31-32).

With respect to claim 12, Applicant's invention relates to a system for automatically sharing of digital images, comprising:

obtaining at least one image identifier, comprising an image content identifier (202) and an associated address (page 14, lines 10-12, and page 35, lines 31-32);

automatically analyzing digital images at a location different from said associated address for determining if at least a portion of the images substantially match said image content identifier (202); and

automatically forwarding said images that substantially match said image content identifier (202) to said associated address.

With respect to claim 21, Applicant's invention relates to a computer software product for automatically forwarding an image by a first party (10) to a second party (16) over a communication network (50) comprising a computer readable storage medium having a computer program which when loaded into a computer causes the computer to perform the following steps of:

automatically analyzing a digital media file at a first party (10) for determining if a portion of said at least one digital image file matches an image content identifier (202) in said digital media file having at least one digital image file, said image content identifier (202) having an associated electronic address (page 14, lines 10-12, and page 35, lines 31-32) of a second party (16); and

automatically forwarding said digital image from said first party (10) file to said electronic address of said second party (16) over said communication network (50) if said image content identifier (202) is present.

With respect to claim 22, Applicant's invention relates to a computer software product for allowing the automatic sharing of images on different computers, said software comprising a computer readable storage

medium having a computer program which when loaded into a computer of an image forming device causes the computer to perform the following steps of:

- obtaining at least one image identifier comprising an image content identifier (202) and an associated address (page 14, lines 10-14, and page 35, lines 31-32);

- automatically analyzing digital image files at a location different from said associated address for determining if at least a portion of the images represented by digital image files substantially match said image content identifier (202); and

- automatically forwarding said digital image files that substantially match said image content identifier (202) to said associated address (page 14, lines 10-12, and page 35, lines 31-32).

With respect to claim 29, Applicant's invention relates to a method for automatically forwarding a digital media file by a first party (10) to a second party (16) over a communication network (50), said digital media file having at least one digital image file comprising the steps of;

- automatically analyzing a digital image media file for determining if a portion in said digital image file matches a content identifier (202) at a first location, said image content identifier (202) having an associated electronic address (page 14, lines 10-12, and page 35, lines 31-32) remote from said first location;

- automatically forwarding said digital image from said first location (10) to said electronic address over said communication network (50) if said image content identifier (202) is present; and

- automatically updating said content identifier (202) to reflect a change in said content identifier.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

Whether claims 4, 7, 10, 12, 20-22, and 29-30 are patentable under 35 USC § 103 (a) over Capps, U.S. Patent Publication No. 2002/0111813 [Capps] in view of Lloyd-Jones U.S. Patent Publication 2002/0055955 [Lloyd-Jones], further in view of Goldberg, U.S. Publication 2004/0008872.

Whether claim 11 is patentable under 35 USC § 103 (a) over Capps, Lloyd-Jones and Goldberg, in view of Davis U.S. Publication 2002/0001395.

Arguments

Claims 4, 7, 10, 12, 20-22, and 29-30 are patentable under 35 USC § 103 (a) over Capps, U.S. Patent Publication No. 2002/0111813 [Capps] in view of Lloyd-Jones U.S. Patent Publication 2002/0055955 [Lloyd-Jones], further in view of Goldberg, U.S. Publication 2004/0008872.

Independent claims 4, 7, 10, 12, 21, and 22 all include the limitation of analyzing an image to determine if an image content identifier is present; the image content identifier having an associated address and if present automatically sending the image to an associated address. Claims 4, 7, 10, 21 recite that the associated address is an electronic address and the image is sent over a communication network.

Capps fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants' independent claims. As admitted by the Office Action, Capps does not disclose an image content identifier. The Examiner relies on Lloyd-Jones for teaching associating an electronic address with the icon.

In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). In fact, the Federal Circuit

explained that the specification is "'usually . . .dispositive. . . [and] the single best guide to the meaning of a disputed term.'" Id. (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317.

Capps' program module parses an electron document to identify a person, retrieves data relevant to the person, and compares the retrieved data to at least one electronic database using conventional techniques. See [0053]. Applicants respectfully submit that the electronic database is not an image content identifier as recited and defined by Applicants. More specifically, Capps identifies "characteristics of a person or persons" (i.e., any data that represents at least one person. See Abstract) and then compares these characteristics to information contained in a database. See [0052] and [0053]. In sharp contrast, Applicants' claims require analyzing a digital image media file for determining if a portion of said at least one digital image file matches an image content identifier. Furthermore, Capps fails to disclose an image content identifier having an associated electronic address of a second party. Moreover, if Capps fails to disclose an image content identifier, Capps' cannot be said to disclose an image content identifier having an associated address of a second party. Nor is there any teaching or suggestion of automatically forwarding of the images to the associated address as taught and claimed by Applicants.

Item 330 of Fig. 3 of Capps, cited by the Examiner, merely identifying an individual in an image. There is no teaching or suggestion of having an address associated with that image. One having identified the individual, then information is retrieved. See Paragraph [0053]. In the present invention a pre-established image content identifier is associated with an address. In Capps, there is no pre-established icon having an associated address for automatically forwarding of an image as claimed by applicants. The information retrieved is obtained only after identification of information, which is opposite to the present invention. The associated information with the content identifier is pre-established in the present invention. Capps obtains the information after identification of the content. The pre-established address is important to the

present invention, as the image is to go to a specific pre-identified address. In Capps there is no knowing of what address or information that may be retrieved. Applicants, respectfully submits that Capps could not teach or suggest the invention as taught and claimed by applicants.

Goldberg fails to remedy the deficiencies of Capps as Goldberg fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated address of a second party as required by Applicants' independent claims. Goldberg was cited to disclose facial identifier functionality. Goldberg does not disclose image content identifier having an associated address of a second party as claimed by Applicants.

Lloyd-Jones fails to remedy the deficiencies of Capps and Goldberg as Lloyd-Jones fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants' independent claims. Rather, Lloyd-Jones discloses that a user can annotate an image by associating metadata with icons and then dragging and dropping the icon on an image. *See* Fig. 1, step 109 and [0029, 0030]. The metadata associated with the selected icon describes a person's name and email address, and is stored in a list associated with the image file in a database along with the position where the icon was dropped within the image. *See* Fig. 1, step 113 and [0039]. If a user wished to e-mail images to another person, an e-mail application must search another list associated with another image. *See* [0039]. Accordingly, there is nothing in Lloyd-Jones that discloses an image content identifier having an associated electronic address of a second party and automatically forwarding the image to the associated address.

Applicants respectfully contend that a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
 - 2) there must be a reasonable expectation of success; and
 - 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.
- (M.P.E.P. §2142).

Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

For example, it is respectfully submitted that Goldberg fails to provide any suggestion to implement or otherwise be combined with an apparatus for annotating an image as described in Lloyd-Jones. Moreover, Lloyd-Jones fails to provide any suggestion to implement or otherwise be combined with a system for recognizing a patron’s face as described in Goldberg.

Claim 11 is patentable under 35 USC § 103 (a) over Capps, Lloyd-Jones and Goldberg, in view of Davis U.S. Publication 2002/0001395.

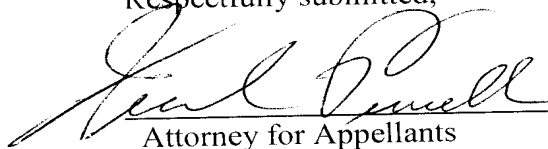
It is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fourth applied prior art reference to Davis is moot, inasmuch as the combination of Capps, Goldberg, Lloyd-Jones and Davis still lack any teaching, disclosure, or suggestion concerning a content identifier having an associated address of a second party as previously discussed.

Therefore, in view of the above remarks, Applicants' independent claims and their dependents are patentable over the cited references.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of the Claims.

Respectfully submitted,



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Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Appendix I - Claims on Appeal

4. A method for automatically forwarding a digital media file by a first party to a second party over a communication network, said digital media file having at least one digital image file comprising the steps of;

automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party; and

automatically forwarding said digital image from said first party to said electronic address of said second party over said communication network if said image content identifier matches a portion of said image.

7. A method for identifying images by a computer for communication of said images over a communication network to a designated remote location, comprising the steps of:

automatically analyzing a digital image;

identifying a feature within said digital image by said computer using pre-established image content identifier having an associated electronic address at a first location; and

automatically transmitting said image to a second remote location using the associated electronic address over a communication network for displaying or storing said image based on identifying said feature within said image.

10. A system for automatically sharing of images over a communication network, comprising:

- obtaining at least one image identifier comprising an image content identifier and an associated electronic address;
- automatically analyzing digital images at a first location different from said associated electronic address for determining if the said image content identifier substantially matches a portion of said images; and
- automatically forwarding said images that substantially match said image content identifier over said communication network to said associated electronic address.

11. The system according to claim 10 wherein said images are forwarded to a fulfillment provider for providing goods and/or services with respect to said at least one digital image file.

12. A system for automatically sharing of digital images, comprising:

- obtaining at least one image identifier, comprising an image content identifier and an associated address;
- automatically analyzing digital images at a location different from said associated address for determining if at least a portion of the images substantially match said image content identifier; and

automatically forwarding said images that substantially match said image content identifier to said associated address.

21. A computer software product for automatically forwarding an image by a first party to a second party over a communication network comprising a computer readable storage medium having a computer program which when loaded into a computer causes the computer to perform the following steps of:

automatically analyzing a digital media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier in said digital media file having at least one digital image file, said image content identifier having an associated electronic address of a second party; and

automatically forwarding said digital image from said first party file to said electronic address of said second party over said communication network if said image content identifier is present.

22. A computer software product for allowing the automatic sharing of images on different computers, said software comprising a computer readable storage medium having a computer program which when loaded into a computer of an image forming device causes the computer to perform the following steps of:

obtaining at least one image identifier comprising an image content identifier and an associated address;

automatically analyzing digital image files at a location different from said associated address for determining if at least a portion of the images represented by digital image files substantially match said image content identifier; and

automatically forwarding said digital image files that substantially match said image content identifier to said associated address.

29. A method for automatically forwarding a digital media file by a first party to a second party over a communication network, said digital media file having at least one digital image file comprising the steps of;

automatically analyzing a digital image media file for determining if a portion in said digital image file matches a content identifier at a first location, said image content identifier having an associated electronic address remote from said first location;

automatically forwarding said digital image from said first location to said electronic address over said communication network if said image content identifier is present; and

automatically updating said content identifier to reflect a change in said content identifier.

30. The method according to claim 29 wherein said content identifier is the appearance of an individual and said change comprises a change in the appearance of said individual.

Appendix II - Evidence

NONE

Appendix III – Related Proceedings

NONE